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10/605,904	11/05/2003	Monica P. Felder	014682.1	2903
44870	7590	10/05/2005	EXAMINER	
MOORE & VAN ALLEN, PLLC P.O. Box 13706 Research Triangle Park, NC 27709			FABER, DAVID	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,904

Applicant(s)

FELDER ET AL.

Examiner

David Faber

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the application filed 5 November 2003.

This action is made Non-Final.

2. Claims 1-36 are pending. Claims 1, 14, 21, 26, and 32 are independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13, 14-20, and 32-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4 and 14 are vague, and indefinite of whom or what is performing the limitations in the claim.

5. Claim 32 recites the limitation "each affected book" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Any claims not specifically addressed, above, are being objected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Section 2100 of the MPEP states:

b) Nonfunctional Descriptive Material

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided.

Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).)

The policy that precludes the patenting of nonfunctional descriptive material would be easily frustrated if the same descriptive material could be patented when claimed as an article of manufacture. For example, music is commonly sold to consumers in the format of a compact disc. In such cases, the known compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture.

Office personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

Claims 1 and 14 are directed towards a method. This method does not require a computer for execution and is thus, nonstatutory. Note that amending Claims 1 and 14 to recite --computer implemented method -- would overcome this rejection.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 7-11, 13, 14-15, 18-20, 26, and 30-31 rejected under 35 U.S.C. 102(b) as being anticipated by Moody et al (US Patent #5,890,177, patented 3/30/1999).

As per independent Claim 1, Moody et al discloses a method comprising:

- assigning a predetermined number of line items to each writer; (Abstract, lines 1-3 – a completed document contains a predetermined number of line items. These predetermined line items are sent to multiple editors.)
- reviewing and investigating each assigned line item; and (Abstract, lines 3-5 – editing a document thoroughly involves reviewing and investigating each line)
- performing any changes related to each assigned line item across all affected books. (Abstract, lines 3-5 – Each editor edits the lines in the document thus are performing changes. In addition, since a book is made of a document or multiple documents, a document is considered a book.)

As per dependent Claim 2, Claim 2 recites similar limitations as in Claim 1 and is rejected under rationale. Furthermore, Moody et al discloses a method further comprising:

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- electronically accessing each affected book to perform any changes (Column 4, lines 37-42 – the author and editors use a word progressing program to edit their document, thus each is electronically accessing it.)

As per dependent Claim 3, Claim 3 recites similar limitations as in Claim 1 and is rejected under rationale. Furthermore, Moody et al disclose a method:

- each change is performed across all affected books regardless of book ownership. (Column 4, line 10-13 – Each editor who edited the copy of the original document edited it regardless of not actually owning the original document.)

As per dependent Claim 7, Moody et al discloses a method further comprising:

- sending a notice in response to completion of any changes related to each line item. (Column 4, lines 46-51 – the editor responds by means of email or an electronic transmission with the edited document on the completion of editing the document.)

As per dependent Claim 8, Claim 8 recites similar limitations as in Claim 1 and is rejected under rationale. Furthermore, Moody et al discloses a method further comprising:

- sending a notice in response to completion of any changes related to all assigned line item. (Column 4, lines 46-51 – the editor responds by means of

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email or an electronic transmission with the edited document on the completion of editing the document.)

As per dependent Claim 9, Claim 9 recites similar limitations as in Claim 1 and is rejected under rationale. Furthermore, Moody et al discloses a method further comprising:

- reviewing any changes related to each line item across all books. (Abstract, lines 5-11 – The author reviews any changes from the edits the editors made to the document.)

As per dependent Claim 10, Moody et al discloses a method further comprising:

- closing each line item in response to review and approval of all changes related to the line item. (Column 6, line 66 – Column 7, line 20 – The author reviews the changes the editors provided and approves which changes will be included in the final document. After each edit or line change is approved of reviewing, each is finished, or closed, from being inspected of forming the final document.)

As per dependent Claim 11, Claim 11 recites similar limitations as in Claim 1 and is rejected under rationale. Furthermore, Moody et al discloses a method further comprising:

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- performing a whole book inspection in response to closing all line items associated with the book. (Column 6, line 66 – Column 7, line 20 – During the reviewing and approving the changes from the editors, it is inherent that the author is inspecting of the changes that were added, approving the changes, and including the approved changes to add to the original document which in the end would be called the final document when completed.)

As per dependent Claim 13, Claim 13 recites similar limitations as in Claim 1 and is rejected under rationale. Furthermore, Moody et al discloses a method further comprising:

- assigning each writer responsibility for a selected number of books. (Column 4, lines 10-13; 28-29 – the author has the desire to obtain feedback, thus assigns editors the responsibility of reviewing the author's selected number of documents, one document in this instance, by transmitting the document to the editors to be reviewed.)

As per independent Claim 14, the applicant discloses the limitations similar to those in Claim 1. Claim 14 is similarly rejected under Moody et al. Furthermore, Moody et al discloses a method comprising:

- reviewing any changes for each line item across all books; and (Abstract, lines 5-11 – The author reviews any changes from the edits the editors made to the document.)

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- closing each line item in response to review and approval of all changes related to the line item across all books. (Column 6, line 66 – Column 7, line 20 – The author reviews the changes the editors provided and approves which changes will be included in the final document. After each edit or line change is approved of reviewing, each is finished, or closed, from being inspected of forming the final document.)

As per dependent Claim 15, Claim 15 recites similar limitations as in Claim 3 and is rejected under rationale.

As per dependent Claim 18, Claim 18 recites similar limitations as in Claim 7 and is rejected under rationale.

As per dependent Claim 19, Claim 19 recites similar limitations as in Claim 9 and is rejected under rationale.

As per dependent Claim 20, Claim 20 recites similar limitations as in Claim 11 and is rejected under rationale.

As per independent Claim 26, Claim 26 recites similar limitations as in Claim 1 and is rejected under rationale. Furthermore, Moody et al discloses a method further comprising:

- means for assigning a predetermined number of line items to each writer; (Abstract, lines 1-3 – a completed document contains a predetermined number of line items. These predetermined line items are sent to multiple editors.)

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- a system memory to store line item assignments; (Column 3, lines 21-23)
- at least one book storable on the system memory, and (Column 3, lines 21-23
– Moody et al discloses memory for temporary storage of information, thus a document has the ability to be stored in temporary storage memory.)
- means for accessing and performing any changes related to each line item across all affected books. (It is inherent that one of the ordinary skill in the art is able to retrieve the document from memory or storage to perform any changes when necessary.)

As per dependent Claim 30, Claim 30 recites similar limitations as in Claim 7 and is rejected under rationale.

As per dependent Claim 31, Claim 31 recites similar limitations as in Claim 10 and is rejected under rationale.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4-5, 16-17, and 27-29 rejected under 35 U.S.C. 103(a) as being unpatentable over (US Patent #5,890,177, patented 3/30/1999) in further in view of (Microsoft, "Release Notes for Windows XP Service Pack 1 and Service Park 1a," published 9/9/2003).

As per dependent Claims 4 and 5, Claims 4 and 5 recites similar limitations as in Claim 1 and is rejected under rationale. Furthermore, Moody et al discloses a method further comprising:

- storing the document in a selected location in a memory. (Column 3, lines 21-23, 31-39 and Column 7, lines 55-58 – Moody et al discloses memory for permanent storage of information, e.g. a document, thus one has the ability to store a document in memory. In addition, Moody et al disclosed different locations of storage, i.e. diskette, where information, such as a document, is stored.)

However, Moody et al fails to specifically disclose preparing a document that includes a description for each change for each book, and a pointer associated with each description of each change to link to a current version of the affected book.

However, Microsoft discloses a release notes document that lists the changes of its Windows XP Service Pack 1 update. (Microsoft, pages 1-3) In addition, each change has an ID that is hyperlinked pointing to a separate document associated with each description of the change to the current version. (Microsoft, pages 1-3)

It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to have combined Moody et al's method with Microsoft's method of a document release notes since it would have allowed the user obtain information about the updated version and the changes that were addressed.

As per dependent Claims 16 and 17, Claims 16 and 17 recite similar limitations as in Claim 4 and 5 and is rejected under Moody et al and Microsoft.

As per dependent Claims 27-29, the applicant recites the system for performing the method of Claims 4 and 5. Therefore, Claims 27-29 are similarly rejected under Moody et al and Microsoft.

11. Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over (US Patent #5,890,177, patented 3/30/1999) in further in view of (Online Training Solutions, Inc, "Microsoft Office Word 2003 Step By Step," published 9/24/2003).

As per dependent Claim 6, Claims 6 recites similar limitations as in Claim 1 and is rejected under rationale. Furthermore, Moody et al fails to specifically disclose tracking line items and changes related to the line items. However, Online Training Solutions, Inc. discloses a method in Microsoft Word that tracks changes and which lines the changes occur on. (Pg 1-2, Fig 1) Figure 1 discloses text overwritten and has a comment balloon pop up to indicate what text was just overwritten. The comment balloon points to the line that was changed. In addition, it would have been well-known to one of the ordinary skill in the art to use the line number indicator located within the status bar in Microsoft Word to determine which line was change once the balloon indicator appeared indicating the change.

It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to have combined Moody et al's with Online Training Solution, Inc's disclosure since it would have allowed a user to be able to make revisions to a document without losing the original text.

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al (US Patent #5,890,177, patented 3/30/1999).

As per dependent Claim 12, Claim 12 recites similar limitations as in Claim 1 and is rejected under rationale. Furthermore, Moody et al fails to specifically disclose correcting any structural, retrieval or usability problems associated with each book. However, Moody et al does disclose that other editors review the original document, then return the changes to the author. Then the author reviews and approves all the changes submitted by the editors. It was well-known to one of the ordinary skill in the art that when the editors was reviewing the document and when the author was reviewing the changes by the editors that each were correcting any structural, retrieval or usability problems in the document.

It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to have combined Moody et al's method with correcting any structural, retrieval or usability problems since it would have allowed a user to produce a well-structured, formal document.

13. Claims 21-25, 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US Patent #5,890,177, patented 3/30/1999) in further in view of (Online Training Solutions, Inc, "Microsoft Office Word 2003 Step By Step," published 9/24/2003) in further view of (Microsoft, "Release Notes for Windows XP Service Pack 1 and Service Pack 1a," published 9/9/2003).

As per independent Claim 21, Claim 21 recites similar limitations as in Claims 6 and is rejected under rationale. Furthermore, Moody et al discloses a system comprising:

- a processor to track each line item, wherein a predetermined number of line item are assigned to each writer; and

Based on the rejection of tracking line items and changes in Claim 6, and the rationale incorporated within, Moody et al discloses a processor (Figure 1, block 105) that runs the operating system (Column 3, lines 63-65) which inherently processes the tracking feature in a word processing program. In addition, Moody discloses a completed document sent to editors (Abstract, lines 1-3), whereby a complete document is a predetermined number of line items.

- a system memory associated with the processor to store at least one book, the at least one book being accessible to perform any changes related to each line item effecting the at least one book.

(Column 3, lines 19-27 – The system includes memory that is connected to the processor by a bus. In addition, Column 3, lines 31-39, Moody et al discloses a list of mass storage devices in which data is stored. One of the ordinary skill in the art is able to retrieve the book from memory or storage to perform any changes. In addition, since a book is made up consisting a document or multiple documents, a document is considered a book.)

As per dependent Claim 22, Moody et al discloses a method further comprising:

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- at least one input device to make changes related to any line items requiring such changes. (Column 3, lines 41-43 – A keyboard is usable to make changes to any line items requiring a change.)

As per dependent Claims 23-25, Claim 23-25 recites similar limitations as in Claims 21 and is rejected under rationale Moody et al discloses a method further comprising:

- stored the document in a selected location in a memory. (Column 3, lines 21-23, 31-39 and Column 7, lines 55-58 – Moody et al discloses memory for permanent storage of information, e.g. a document, thus one has the ability to store a document in memory. In addition, Moody et al disclosed different locations of storage, i.e. diskette, where information, such as a document, is stored.)

Moody et al and Online Training Solutions, Inc. both failed to specifically disclose preparing a document including a description for change for each book, and a pointer associated with each description of each change to link to a current version of the affected book. However, Microsoft discloses a release notes document that lists the changes of its Windows XP Service Pack 1 update. (Microsoft, pages 1-3) In addition, each change has an ID that is hyperlinked pointing to a separate document associated with each description of the change to the current version. (Microsoft, pages 1-3)

It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to have combined Moody et al's method and Online Training Solutions, Inc's method with Microsoft method of document release notes since it would

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have allowed the user obtain information about the updated version and the changes that were addressed.

As per independent Claim 32, Claims 32 recites similar limitations as in Claim 6 and is rejected under rationale. Furthermore, Moody et al discloses a system comprising:

- tracking each line item; and (Refer to Claim 6 above for rejection)
- facilitating any changes related to each line item across each affected book.

(Abstract, lines 5-11 & Column 3, lines 41-56 – Numerous computer components are disclosed, e.g. the keyboard, enabling the author in reviewing any changes from the edits the editors made to the document and using a network to communicate between the editors and the author.)

As per dependent Claims 33, the applicant recites a computer-readable medium having computer-executable instructions for performing the method of Claims 8.

Therefore, Claims 33 are similarly rejected under Moody et al.

As per dependent Claims 34-35, the applicant recites a computer-readable medium having computer-executable instructions for performing the method of Claims 23-25. Therefore, Claims 34-35 are similarly rejected under Moody et al, Online Training Solutions, Inc. and Microsoft.

As per dependent Claims 36, the applicant recites a computer-readable medium having computer-executable instructions for performing the method of Claims 10.

Therefore, Claims 36 are similarly rejected under Moody et al.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Dabney et al (US Patent #6,643,663): Discloses method of editing data in a system
- Hughes (US Patent #6,275,223): Discloses method of collaborating on editing lines of data code.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

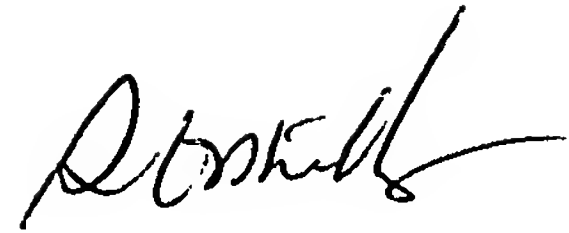
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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David Faber
Examiner
Art Unit 2178

DF



STEPHEN HONG
SUPERVISORY PATENT EXAMINER